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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/505,422

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EXAMINER

CREPEAU, JONATHAN

ART UNIT

PAPER NUMBER

1745

MAIL DATE

DELIVERY MODE

09/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/505,422	<b>Applicant(s)</b> OTSUKI ET AL.	
	<b>Examiner</b> Jonathan S. Crepeau	<b>Art Unit</b> 1745	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
     4a) Of the above claim(s) 1-13 and 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action addresses claims 1-26. Claims 1-13 and 17-26 remain withdrawn from consideration. Although they have been amended, claims 14-16 remain rejected over JP '861 (note the 35 USC 103 rejection now applied to claims 14 and 15). Additionally, claims 14-16 are newly rejected under 35 USC 112 second paragraph as necessitated by amendment. Accordingly, this action is made final.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites "particles of manganese dioxide" in the second-to-last line. However, this recitation is believed to be in conflict with the materials recited in step (I) of the claim. It appears from the specification that the manganese dioxide is only present in a primary battery, whereas claim 14 recites a secondary battery. Thus, it is suggested that "manganese dioxide" be deleted and the correct materials be inserted into this location. The claim has been interpreted in this manner herein.

***Claim Rejections - 35 USC § 102/103***

4. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2001-283861.

In [0055] of the machine translation, the reference teaches a positive electrode comprising  $\text{LiCoO}_2$  particles in an amount of 86 weight parts and  $\text{BaTiO}_3$  particles in an amount of 5 weight parts. In [0062], the reference teaches that  $\text{TiO}_2$  may be used instead of  $\text{BaTiO}_3$ . In [0074] it is also taught that alumina may be used. Although the reference does not teach the claimed process limitations, the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See also MPEP §2113. Accordingly, the instant claims are not considered to be distinguished over JP '861.

***Claim Rejections - 35 USC § 103***

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-283861 in view of JP 63-121250.

JP '861 is applied for the reasons stated above. Further, in the disclosed example, the mass of the titanium dioxide is 5.8% of the mass of the lithium cobalt oxide. However, the reference does not expressly teach that this range is 0.5% to 4%, as recited in claim 16.

According to the International Search Report, JP '250 teaches a positive electrode comprising particles of MnO<sub>2</sub> and TiO<sub>2</sub>. The titanium dioxide is present in an amount of 3 to 10 mol% (2.8-9.0 wt%) of the manganese dioxide.

Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the artisan would be motivated to use an amount of titanium dioxide in the electrode of JP '861 falling within the range disclosed by JP '250. As disclosed in the abstract, the purpose of the invention of JP '250 is "to easily eliminate a high potential part at initial discharging time by adding an oxide." Accordingly, the artisan would be motivated to use an amount of titanium dioxide in the electrode of JP '861 falling within the range disclosed by JP '250, thereby rendering the claimed range obvious.

***Response to Arguments***

6. Applicant's arguments filed September 4, 2007 have been fully considered but they are not persuasive. Applicants assert that the amendatory language distinguishes the claims over JP

'861. However, for the reasons set forth above, this is not believed to be the case. The structure of the electrode of JP '861 appears to be identical to the structure of the electrode of the instant claims. Even if the structures are not identical, the structure of the claimed electrode must be shown to be unobvious over the structure of JP '861. Applicant's remarks spanning pages 12 and 13 of the response are noted, but a mere statement of the supposed advantages of the invention is not sufficient to distinguish over JP '861. Arguments of counsel cannot take the place of evidence in the record where evidence is necessary. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); MPEP 2145(I).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Crepeau whose telephone number is (571) 272-1299. The examiner can normally be reached Monday-Friday from 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan, can be reached at (571) 272-1292. The phone number for the organization where this application or proceeding is assigned is (571) 272-1700. Documents may be faxed to the central fax server at (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jonathan Crepeau  
Primary Examiner  
Art Unit 1745  
September 6, 2007